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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,376	04/20/2004	Nozomu Tamoto	252035US DIV	3769

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,376

Applicant(s)

TAMOTO ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-32 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,7-25,28-32 and 47-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,27 and 51-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. Claims 1, 2, 7-32, and 47-60 are now pending in the application. Claims 1, 2, 7-25, 28-32, and 47-50 are withdrawn.
2. All outstanding rejections are withdrawn in light of applicant's amendment filed 5/24/2005.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 5/24/2005. In particular, claim 26 has been amended to specify the organic compound as a polymer or oligomer with at least one carboxyl group. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The generic term "a doped metal oxide" does not have support in the specification as originally

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filed. In particular, on page 38, lines 2-3, support is had only for the certain species, i.e., tin oxide doped with antimony and indium oxide doped with tin.

Claim Rejections - 35 USC § 102

6. Claims 26, 51-56, 58, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakao et al (US 4,559,288).

Nakao et al discloses an electrophotographic photoreceptor having an interlayer, wherein the interlayer comprises colloidal silica and/or alumina (col. 7, line 36-62); a polymer having an acid value of 10-100 (i.e., organic compound) (col 4, line 18 to col. 7, line 10); and another polymer (i.e., binder) (col. 7, line 11-36); and a plurality of solvents (e.g., col. 9, lines 19-30). With respect to the presently claimed resistivity $10^{10} \Omega \cdot \text{cm}$ of the filler, it is the examiner's position that alumina and silica inherently have it since applicant also utilizes alumina and silica and a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In light of the above, it is clear that Nakao et al anticipates the presently cited claims.

7. Claims 26, 51, 52, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Patzschke et al (US 6,329,020).

It is noted that the intended use of "for an outermost layer of an electrophotographic photoreceptor" has not been given patentable weight. Case law holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a

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purpose or intended use for the invention, the preamble is not a claim limitation.” See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Patzschke et al discloses a coating material (abstract) comprising filler/pigment such as carbon black (col. 20, line 51; col. 12, lines 35-50; col. 16, line 56); conventional rheological organic additives such as carboxyl group-containing polyacrylate copolymers with an acid number of 60 to 780 (col. 13, lines 52-65); an aqueous dispersion of a polymer (i.e., binder resin); and a plurality of solvents (col. 13, line 66 to col. 14, line 9).

In light of the above, it is clear that Patzschke et al anticipates the presently cited claims.

Claim Rejections - 35 USC § 102/103

8. Claim 27 is rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakao et al (US 4,559,288) or Patzschke et al (US 6,329,020).

The discussions with respect to Nakao et al and Patzschke et al in paragraphs 6 and 7 above are incorporated here by reference.

It is noted that claim 27 is a product-by-process claim and therefore “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Thus, given that Nakao et al and Patzschke et al disclose the presently claimed composition, it is clear that Nakao et al and Patzschke et al anticipate the presently cited claim.

While Nakao et al and Patzschke et al do not explicitly disclose a process of mixing their ingredient with an alumina ball mill, given that both disclose the presently claimed composition it is considered that that it would have been obvious to one of ordinary skill in the art to obtain the same final product, absent a showing of criticality for the presently claimed process, and thereby arrive at the presently cited claim.

Claim Rejections - 35 USC § 103

9. Claims 26, 27, and 51-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanamori et al (US 6,335,061) in view of Patzschke et al (US 6,329,020).

It is noted that the intended use of “for an outermost layer of an electrophotographic photoreceptor” has not been given patentable weight. Case law holds that “where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Kanamori et al discloses a coating composition comprising colloidal silica and/or alumina (col. 18, lines 58-62) and other fillers (col. 22, lines 49-51; col. 23, lines 31-59); a dispersing agent such as polyacrylate (col. 23, line 64 to col. 24, line 4); a binder resin (abstract); a plurality of solvents (e.g., Table 2, col. 29, lines 33-35); and coupling agents (col. 24, line 16). Note that since Kanamori et al discloses the same fillers as presently claimed, the fillers of Kanamori et al intrinsically have the presently claimed resistivity.

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While Kanamori et al discloses the use of a polyacrylate dispersing agent, it fails to teach the acid value of it.

Patzschke et al discloses a coating composition and teaches that polyacrylate rheological additives include preferred carboxyl group-containing polyacrylate copolymers with an acid number of 60-780 which is used to wet the metal pigments/additives (col. 13, lines 52-65).

Given that Kanamori et al is open to the addition of polyacrylate dispersing agents and further given that polyacrylates with the presently claimed acid numbers are advantageous rheological additives as taught by Patzschke, it would have been obvious to one of ordinary skill in the art to utilize a polyacrylate with the presently claimed acid number in the coating composition of Kanamori et al and thereby arrive at the presently cited claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/17/2005

vr




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